

### **Remarks**

Claims 1-18 were pending.

Claims 1 and 15 are amended.

Claims 12 and 16 are cancelled.

Claims 2, 4, 5, 7-11, 13, 14 and 17 and 18 are original.

Claims 3 and 6 are as previously presented.

The application now contains claims 1-11, 13-15, 17 and 18.

Claim 1 is amended at the end of the second line to incorporate, using Markush language, limitations from original claim 12. Omitted from the instant amendments are the terms "epoxy resin", "polyester resin" and "alkyd resin" which were present in original claim 12 but is deleted from the instant claims. Support is found in original claim 12.

Claim 15 is amended to delete the phrase "a first" appearing immediately prior to the term "component (a)" in line 2; to be an independent claim by deleting the phrase "according to claim 1", inserting the limitations describing component (a) and (b) from instantly amended claim 1 and inserting the limitation "aqueous or alcoholic" immediately following the phrase "distillation of the" and immediately prior to the term "solvent" near the end of the claim, support is found in claim 1; and to delete "and optionally, adding a second component (a)" from the end of the claim.

No new matter is added.

### **Rejections**

Claims 15 and 16 are rejected under 35 USC 112 second paragraph. The Action states that the process of claim 15 can not provide the coating of claim 1, because the process of claim 15 removes solvent and claim 1 contains a base which the Examiner suggests could be a solvent. While Applicants respectfully disagree with the analysis found in the present Action, Applicants respectfully submit that the amendments above making claim 15 independent of claim 1 and specifically defining all the elements including the solvent in question addresses potential issues regarding definiteness that may exist.

Applicants therefore respectfully submit that the 35 USC 112 second paragraph rejections are overcome and kindly ask that they be withdrawn.

Claims 1-3, 5-12, 14 and 17-18 are rejected under 35 USC 102(b) over Weinberger, US 6,008,291 which discloses a composition comprising an acid functionalized polyester resin, a base and silica compounds. Also exemplified in Weinberger are related compositions comprising modified epoxy resins and modified alkyd resins.

Applicants respectfully traverse the rejections.

In order to focus on particular features of the instant invention, and to avoid any potential confusion with the compositions of Weinberger, Applicants have amended the claims so that specific resins other than polyester, epoxy and alkyd resins must be present.

Applicants respectfully aver that the instantly amended claims are outside of the disclosure of Weinberger and that no anticipation exists. Applicants therefore kindly ask that the rejections of claims 1-3, 5-12, 14 and 17-18 under 35 USC 102(b) over Weinberger, US 6,008,291 be withdrawn.

Claims 4 and 13 are rejected under 35 USC 103(a) as being obvious over Weinberger, US 6,008,291 in view of Das et. al., US 4,522,958.

Applicants respectfully traverse the rejections.

The instant invention requires the presence of specific resins, particular silica particles and a base. Das is cited by the Examiner to make obvious the alcoholic solvents of instant claim 4 and the pigment of claim 13. Applicants refer to the above discussion regarding Weinberger and respectfully submit that the addition of Das does not remedy the deficiencies noted above.

Applicants respectfully submit that the combination of Das with Weinberger fails to meet the instant limitations and kindly ask that the rejections of claims 4 and 13 under 35 USC 103(a) be withdrawn.

Applicants further respectfully maintain that even though there are some similarities between Das and the instant invention, e.g., the presence of nano-particles and the use of alcoholic solvents, there are also significant differences which much be considered when applying Das. For example, Applicants respectfully point out that all of the examples in Das prepare acidic silica materials. Even

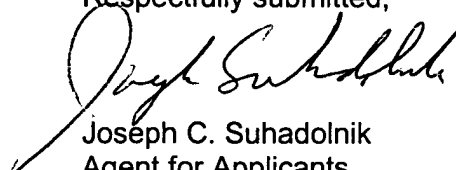
in example 5, wherein ethyl silicate is treated with ammonia, the ammonia is removed and the material acidified with HCl to a pH of 2.4, whereas the instant invention requires a base be present.

Applicants also respectfully note that while a variety of sources for silica particles are found in both Das and Weinberger, neither reference notes any advantage of the instantly specified silica particles. Weinberger specifically states that any available silica dispersion can be used, e.g., column 7 lines 45-47, while Das teaches that when using colloidal silica surface modified materials are superior beginning with column 10 line 41 etc.

In order for a combination of references to make an invention obvious, there must be something in the combined teaching that would lead one to choose the specific elements of the invention from the lists of the possible options in the art. Applicants respectfully point out that nothing in the combined art suggests that the instant combination of specific polymers, specific silica particles and base would have any advantage or value as found by the Applicants.

Applicants respectfully submit that all rejections have been addressed and are overcome and kindly ask that they be withdrawn and that claims 1-11, 13-15, 17 and 18 be found allowable. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

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